

REMARKS

In the Office Action ("OA"), the Examiner rejected claims 1, 15, 16, 18, 20, and 22 under 35 U.S.C. § 103(a) as unpatentable over Wactlar et al., U.S. Patent No. 5,835,667 ("Wactlar") in view of Kazami et al., U.S. Patent No. 6,035,093 ("Kazami"); rejected claims 3, 17, 19, 21, and 23 under 35 U.S.C. § 103(a) as unpatentable over Maruyama et al., U.S. Patent No. 6,453,119 ("Maruyama") in view of Kazami; and rejected claims 5 and 6 under 35 U.S.C. § 103(a) as unpatentable over Maruyama in view of Kim et al., U.S. Patent No. 6,519,415 ("Kim"). Applicants respectfully traverse these rejections for the reasons set forth below.

I. Response to section 103(a) rejection over Wactlar in view of Kazami

The Examiner alleged that claims 1, 15, 16, 18, 20, and 22 are unpatentable over Wactlar in view of Kazami. In response, Applicants respectfully submit that a *prima facie* case of obviousness has not been established for these claims.

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim elements. Furthermore, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03 (8th Ed., Aug. 2001) (quoting *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Third, there must be a reasonable expectation of success. M.P.E.P. § 2143 at pp. 2100-122 to 127.

Claim 1 is directed to an information storage medium comprising a combination of elements including, *inter alia*, "still image information configured to be displayed first in [a]

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

music reproduction unit is set as the still image information being representative of the contents of the music reproduction unit.”

In this rejection, the Examiner alleged that Wactlar teaches all the elements of the claimed invention, but admitted that Wactlar did not disclose still image information configured to be displayed first in the music reproduction unit is set as the still image information being representative of the contents of the music reproduction unit. (OA at p. 3.) The Examiner alleged that Kazami teaches this claim element and that it would have been obvious to modify Wactlar to select the image to be displayed first as a representative image of a file comprising a sequence of images. (OA at p. 3.) Contrary to the Examiner’s allegations, Wactlar and Kazami, taken alone or in combination, fail to teach or suggest all the claim elements and, further, there would be no motivation to combine Wactlar and Kazami.

Wactlar is directed to creating a searchable digital library for text, audio, and video segments. Wactlar, col. 4, lines 31-32. In order to assist with searching, Wactlar’s digital library includes a “function 35” that generates icons for a particular segment of video. Wactlar, col. 13, lines 52-53. When generating the icon, the function 35 selects an image that is representative of the content in the segment of video. Wactlar, col. 13, lines 53-59. However, in order to avoid “misleading” a user, the function 35 selects an image that closely maps to the content of the video segment. Wactlar, col. 13, line 60 through col. 14, line 8. In fact, Wactlar teaches that the function 35 will typically not use the first images that are displayed for a video segment, because they provide “no significant visual clue about the content of the video.” Wactlar, col. 13, lines 60-65. Thus, Wactlar does not teach or suggest at least still image information configured to be displayed first in the music reproduction is set as the still image information being representative of the contents of the music reproduction unit, as recited in claim 1.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Kazami is directed to an image file editing system and method. In Kazami, an image file editing system reads out the leading image from a selected image file. Kazami, col. 1, lines 55-61. The read out image is used as a thumbnail for the image file. Kazami, col. 1, lines 62-66. However, Kazami does not disclose that the image is representative of the content of the file. Thus, Kazami does not teach or suggest at least still image information configured to be displayed first in the music reproduction is set as the still image information being representative of the contents of the music reproduction unit, as recited in claim 1.

Therefore, Wactlar and Kazami, taken alone or in combination, fail to teach or suggest all the claim elements. Accordingly, a *prima facie* case of obviousness has not been established for claim 1. For at least this reason, claim 1 is allowable.

Moreover, one skilled in the art would not have been motivated to modify Wactlar with Kazami. As mentioned above, Wactlar teaches that the function 35 will typically not use the first images that are displayed for a video segment, because they provide "no significant visual clue about the content of the video." In contrast, Kazami specifically teaches that the leading image is selected. Thus, one skilled in the art would not modify Wactlar with Kazami because Wactlar teaches away from method of Kazami. For at least this reason, claim 1 is allowable.

Claims 16, 18, 20, and 22 are allowable at least due to their dependence from allowable claim 1.

Furthermore, claim 15 is directed to a method for reproducing music information from an information storage medium which records audio information associated with a representative image, still image information including the representative image, and management information, wherein the still image information configured to be displayed first in a unit of music reproduction is being set as the representative image. (emphasis added.) As mentioned above,

Wactlar and Kazami, taken alone or in combination, fail to teach or suggest all of these claim elements and, further, there would be no motivation to combine Wactlar and Kazami, much less any reasonable expectation of success. Accordingly, a *prima facie* case of obviousness has not been established for claim 15. For at least these reasons, claim 15 is allowable.

Response to section 103(a) rejection over Maruyama in view of Kazami

The Examiner rejected claims 3, 17, 19, 21, and 23 under section 103(a) as unpatentable over Maruyama in view of Kazami. In response, Applicants submit that Maruyama and Kazami, taken alone or in combination, fail to teach or suggest all the elements recited in the claims.

Claim 3 is directed to an information storage medium comprising a combination of elements including, *inter alia*, “still image information configured to be displayed first is set as the still image information representing the contents of [a] reproduction sequence.”

In this rejection, the Examiner alleged that Maruyama teaches all the elements of the claimed invention, but admitted that Maruyama did not teach still image information configured to be displayed first in the music reproduction unit is set as the still image information being representative of the contents of the music reproduction unit. (OA at p. 6.) The Examiner alleged that Kazami teaches this claim element and that it would have been obvious to modify Maruyama to select the image to be displayed first as a representative image of a file comprising a sequence of images. (OA at pp. 6-7.) Contrary to the Examiner’s allegations, Maruyama and Kazami fail to teach or suggest at least “still image information configured to be displayed first is set as the still image information representing the contents of [a] reproduction sequence.”

Maruyama teaches a digital recording/playback system. Maruyama, col. 4, lines 50-51. In addition, Maruyama teaches that an icon may be generated from a stored representative picture. Maruyama, col. 39, lines 14-15. The stored representative picture is stored in a specific data area. Maruyama, col. 8, lines 8-19. When playing audio or video information, Maruyama’s

system reads a "lead-in area" and first displays information from the location specified by the lead-in area. Maruyama, col. 10, line 2. That is, Maruyama first displays information stored at locations designated by the lead-in area and does not first display the representative picture. Thus, Maruyama fails to teach or suggest at least "still image information configured to be displayed first is set as the still image information representing the contents of [a] reproduction sequence," as recited in claim 3.

Kazami is directed to an image file editing system and method. Similar to Maruyama, in Kazami, an image file editing system reads out the leading image from a selected image file. Kazami, col. 1, lines 55-61. The read out image is used as a thumbnail for the image file. Kazami, col. 1, lines 62-66. However, Kazami does not disclose that the image is representative of the content of the file. Thus, Kazami fails to teach or suggest at least "still image information configured to be displayed first is set as the still image information representing the contents of [a] reproduction sequence," as recited in claim 3.

Therefore, Maruyama and Kazami, taken alone or in combination, fail to teach or suggest all the elements of claim 3. Accordingly, a *prima facie* case of obviousness has not been established for claim 3. For at least this reason, claim 3 is allowable.

Claims 17, 19, 21, and 23 allowable at least due to their dependence from allowable claim 3.

Response to section 103(a) rejection over Maruyama in view of Kim

The Examiner rejected claims 5 and 6 under section 103(a) as unpatentable over Maruyama in view of Kim. In response, Applicants submit that Maruyama and Kim, taken alone or in combination, fail to teach or suggest all the elements recited in the claims.

Claim 5 is directed to a method for setting a representative image comprising a combination of element including, *inter alia*, "recording . . . a still image being coincident with

the representative image of contents of said first audio information before being divided, as a representative image of contents of said second audio information and as a representative image of contents of said third audio information.” Claim 6 is directed to a method for setting a representative image comprising a combination of element including, *inter alia*, “recording . . . the representative image of contents of earlier-reproduced audio information, as a representative image of contents of said sixth audio information, wherein said earlier-reproduced audio information indicates one of said fourth audio information before combining and said fifth audio information before combining, which one is reproduced earlier than the other after being combined,”

In this rejection, the Examiner alleged that Maruyama teaches all the elements of the claimed invention, but admitted it failed to teach “the display of multiple pictures during a single audio playback event.” (OA at pp. 8-11.) The Examiner alleged that Kim teaches the plurality of pictures being displayed with the playing of an audio recording. (OA at pp. 8-11.) Contrary to the Examiner’s allegations, Maruyama and Kim fail to teach or suggest all the elements recited in the claims.

Maruyama teaches a representative picture for each portion recorded on a disc. Maruyama, col. 33, lines 16-41. When information is divided into portions, Maruyama’s system specifies a corresponding representative picture for each portion. Maruyama, col. 8, lines 15-31. Therefore, Maruyama does not teach or suggest at least “recording . . . a still image being coincident with the representative image of contents of said first audio information before being divided, as a representative image of contents of said second audio information and as a representative image of contents of said third audio information,” as recited by claim 5 and “recording . . . the representative image of contents of earlier-reproduced audio information, as a

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

representative image of contents of said sixth audio information, wherein said earlier-reproduced audio information indicates one of said fourth audio information before combining and said fifth audio information before combining, which one is reproduced earlier than the other after being combined,” as recited in claim 6.

Furthermore, Kim fails to cure the deficiencies of Maruyama. Kim teaches that video is divided into a plurality of parts and each part is linked with an inputted still image. (See Kim, col. 3, lines 53-68.) Therefore, after a video is divided, each part of the video is assigned its own still image. Therefore, Kim does not teach or suggest at least “recording . . . a still image being coincident with the representative image of contents of said first audio information before being divided, as a representative image of contents of said second audio information and as a representative image of contents of said third audio information,” as recited in claim 5, and “recording . . . the representative image of contents of earlier-reproduced audio information, as a representative image of contents of said sixth audio information, wherein said earlier-reproduced audio information indicates one of said fourth audio information before combining and said fifth audio information before combining, which one is reproduced earlier than the other after being combined,” as recited in claim 6.

Thus, Maruyama and Kim, taken alone or in combination, fail to teach or suggest all the elements recited in claims 5 and 6. Accordingly, a *prima facie* case of obviousness has not been established for claims 5 and 6. For at least this reason, claims 5 and 6 are allowable.

Conclusion

In view of the foregoing, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: October 30, 2003

By: Richard V. Burgujian Reg 24,014
for Reg. No. 31,744

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com